

**Remarks**

This response is provided in reply to an Office Action mailed **March 23, 2006**. Claims 1-4, 9, 11-14, 18-21, 24-28 were rejected under 35 U.S.C. § 102(e) as being anticipated by Pradhan et al. [US 6968178], and claims 5-8, 10, 15-17, 22-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Pradhan in view of various combinations of references, as detailed further below.

With this response, rejection of claims 1-28 is respectfully traversed. Claims 1-28 remain pending with this application. In view of the subsequent remarks, reconsideration of the above-captioned application is respectfully requested.

**35 U.S.C. §102(e) Rejection of Claims 1-4, 9, 11-14, 18-21, 24-28**

In **paragraph IV** of the Action, claims 1-4, 9, 11-14, 18-21, 24-28 were rejected under 35 U.S.C. 102(e) as being anticipated by Pradhan et al. [US 6968178]. In response, Applicant respectfully traverses the basis of such rejection. For at least the reasons set forth below, Applicant submits that claims 1-4, 9, 11-14, 18-21, 24-28 are not anticipated by Pradhan.

The Manual of Patent Examining Procedure (“MPEP”), in § 2131, states:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 869 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Thus, under 35 U.S.C. § 102, a claim is anticipated *only if* each and every element of the claim is found in the cited reference and the cited reference must show the invention in as complete detail as contained in the claim.

Amended claim 1 recites:

1. A method of transmitting a message from a portable communication device comprising:

preparing the message to be transmitted, wherein preparing includes receiving a user-generated message;

*associating the message with a user-defined event to specify the conditions upon which transmission of the associated message should occur;*

***transmitting the message from the portable communication device upon the occurrence of the user defined event.*** [Emphasis added]

Independent claims 13, 19, and 24 provide, in part, similar limitations as emphasized in claim 1 above. Regarding these elements of claims 1, 13, 19, and 24, the Office Action directs the Applicant's attention to Pradhan (Col. 11; 64-Col.12; 17, Abstract), wherein Pradhan describes how a consumer may set an advertisement filter for a mobile phone. The cited Pradhan art teaches:

"the (telephone) consumer is presented with a display of possible filter categories, for example: holidays, sport, cars, under \$100, under \$50, \$1000-\$5000, clothes, male/female, age target, geographical vicinity of advertiser to be within specific distance of consumer phone,... food, financial, news, music, etc. The user selects which categories are to be excluded and which are to be included." (see Pradhan Col. 11; 66-Col. 12;8)

The cited Pradhan art at least fails to teach the limitations that *a user-defined event specify the conditions upon which transmission of the associated message should occur and transmitting the message from the portable communication device upon the occurrence of the user defined event* as provided in claim 1. The cited Pradhan reference merely teaches that a user may select filter categories for advertisements directed to their phone. Pradhan does not disclose or suggest that the selected advertisement filter categories are conditions upon which transmission of the associated messages should occur.

The advertisement filter of Pradhan is not analogous to the user-defined event of claim 1 because the ad filter of Pradhan does not anywhere suggest or even imply that message transmission *occur* upon satisfaction of a user-defined condition. Pradhan does not specify when message transmission occurs. For example, in Pradhan, the timing of message transmission may

occur at the will of the advertiser, independent of the user-defined filter. Claim 1 of the current application, on the other hand, expressly teaches that message transmission takes place upon the occurrence of a user-defined event (i.e. - a user-defined event to specify a condition upon which transmission should occur).

Claim 1 teaches *transmitting the message from the portable communication device upon the occurrence of the user defined event*. Pradhan fails to teach the *occurrence* of a user defined event at all. Pradhan merely teaches user defined conditions for incoming advertisements whenever they are transmitted, and fails to suggest that the ads are transmitted upon the *occurrence* of a user defined condition.

In this regard, the cited Pradhan reference fails to teach each and every aspect of claim 1 and analogous claims 13, 19, and 24. Accordingly, Applicant respectfully requests that the §102(e) rejection of such claims be withdrawn.

Claims 2-4, 9, 11-12 depend from claim 1. Claims 14, 18 depend from claim 13. Claims 20-21 depend from claim 19. Claims 25-28 depend from claim 24. For at least the reason that dependent claims include the limitations of the claims from which they depend, Applicant submits that claims 2-4, 9, 11-12, 14, 18, 20-21, 25-28 are likewise not anticipated by Brendel.

### **35 U.S.C. §103 Rejection of Claims 5-8, 10, 15-17, 22-23**

In **paragraphs VI-IX**, claims 5-8, 10, 15-17, 22-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pradhan in view of various other references. For at least the reasons set forth below, Applicant submits that claims 5-8, 10, 15-17, 22-23 are not rendered obvious by Pradhan.

Pradhan is cited as teaching the limitations of base claims from which the rejected dependent claims depend. However, as argued above, the cited Pradhan reference fails to

disclose or suggest all of the limitations provided in claim 1 and analogous base claims 13, 19, and 24. Whether or not the other cited references disclose the limitations cited by the Office action, Pradhan does not teach or suggest at least the limitations that *a user-defined event specify the conditions upon which transmission of the associated message should occur* and *transmitting the message from the portable communication device upon the occurrence of the user defined event* as provided in claim 1 and analogous base claims 13, 19, and 24 as detailed above.

For at least the reason that Pradhan does not teach or suggest the above-cited claim limitations, no modification of Pradhan teaches or suggests the invention as recited in claims 5-8, 10, 15-17, 22-23. Thus, the Applicant respectfully submits that dependent claims 5-8, 10, 15-17, 22-23 are not rendered obvious by Pradhan and respectfully requests that the rejection of such claims be withdrawn.

**Conclusion**

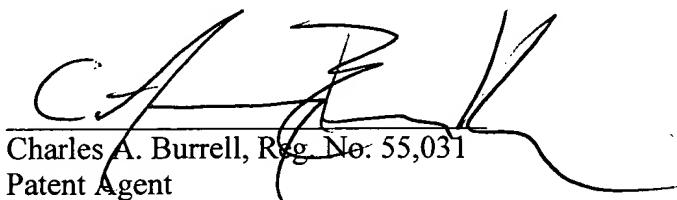
The foregoing is submitted as a full and complete response to the Office Action mailed **March 23, 2006**. In view of the foregoing remarks, Applicant respectfully submits that pending claims 1-28 are in condition for allowance and a notification of such allowance is respectfully requested.

Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #50-0221.

If the Examiner believes that there are any informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned at (503) 439-8778 ext 235 is respectfully solicited.

Respectfully submitted,  
Alex D. Starkovich, et al.

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Charles A. Burrell, Reg. No. 55,031  
Patent Agent  
Intel Corp.

c/o Blakely, Sokoloff, Taylor & Zafman, LLP  
12400 Wilshire Blvd., Seventh Floor  
Los Angeles, CA 90025-1026  
(503) 264-3059